UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/768,606	12/18/1996	ANDREW T. BUSEY	4068.P002X	1226

7590   01/21/2004

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 WILSHIRE BLVD
7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER
KINDRED, ALFORD W   .

ART UNIT	PAPER NUMBER
2172	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/768,606	TAKANASHI ET AL.
	Examiner	Art Unit
	Alford W. Kindred	2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 June 2003</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>10-83</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>10-83</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   30+32

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: Reconsideration, filed on 06/6/03.

This action is made final.

Claim Rejections - 35 U.S.C. § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
>
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
>
> the prior art are such that the subject matter as a whole would have been obvious at the time the
>
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 10-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Volano, "VolanoChat Java solution turns ordinary web sites into interactive money

makers", Business Wire, pp.1-2, in view of Judson, U.S. Patent Number 5,572,619, filed

10/19/95, class 395/793, title "Web browser with dynamic display of information objects

during linking", and further view of Anupam et al., US 5,862,330.

     With respect to independent claim 10, **Volano** discloses, "establishing a chat

region controlled by a chat client" ("VolanoChat works with all Java-compatible browsers

. . . can accommodate large numbers of simultaneous real-time interactions . . . such as

browser plug-ins, Internet chat . . ."--page 1 of 2). **Volano** does not disclose "a browser

frame controlled by a browser client . . .". **Anupam** discloses "a browser frame

controlled by a browser client . . . with the browser region" (see fig. 1,--sheet 1 of 4. It

would have been obvious at the time of the invention for one of ordinary skill in the art to

have combined the teachings of Anupam and Volano above, because using the steps of

a browser client that is controlled by a browser frame, would have given those skilled in

the art the ability to incorporate chat functions in a user's browser. **Volano** does not

disclose "in response to a command received by a computer, establishing a browser . .

.". **Judson** discloses "in response to a command received by a computer, establishing

a browser . . ." ("client machine having a browser, wherein the information objects are

downloading of a hypertext object, selectively displaying one of the stored information

objects . . ."--column 10, line 53). It would have been obvious at the time of the

invention for one of ordinary skill in the art to have combined the teachings of Judson "in

response to a command received by a computer, establishing a browser . . ." ("client

machine having a browser, wherein the information objects are downloading of a

hypertext object, selectively displaying one of the stored information objects . . ."--

column 10, line 53) with the teachings of Volano above, because using the steps of "in

response to a command received by a computer, establishing a browser . . ." would

have given those skilled in the art the tools to create a browser in the an Internet

environment. This give users the ability to user browsers to view and manipulate

information on the Internet via commands of a computer. Volano does not explicitly

teach "wherein chat functions of the chat region and browser functions of the browser

region are synchronized via dynamic linking of chat applications and browser

applications." Anupam et al. teach "wherein chat functions of the chat region and

browser functions of the browser region are synchronized via dynamic linking of chat

applications and browser applications" (see col. 1, lines 41-67 and col. 2, lines 19-64).

It would have been obvious at the time of the invention for one of ordinary skill in the art

to have combined the teachings of Anupam and Volano above, because using the steps

of "wherein chat functions of the chat region and browser functions of the browser

region are synchronized via dynamic linking of chat applications and browser

applications", would have given those skilled in the art the tools to dynamically link a

chat element with a browser, because this would increase the way browsers process

chat functions.

With respect to dependent claim 11, **Volano** discloses "displaying the chat region

and the browser region simultaneously on the display device; and allowing a user to

concurrently perform a chat function, a browser function or both" ("simultaneous real-

time interactions . . . user-group support . . ."--page 1 of 2).

With respect to dependent claim 12, **Volano** discloses "establishing the browser

and chat regions on the display device, the command being received by the computer

from a user or a computer network" ("optimized for novice Web users that just want to

chat . . . all the Java chat applications . . ."--page 1 of 2).

With respect to dependent claim 13, **Volano** discloses "with a chat client resident

on the computer, processing chat content using a browser server for display in the chat

region; with a browser resident on the computer, processing a document or other

content for concurrent display in the browser region" ("Volano markets Java solutions

for multi-user environments . . . a Web-based chat solution written entirely in Java . . ."page 2 of 2).

With respect to dependent claim 14, **Volano** discloses "linking the chat client to the browser so that the chat client controls the content displayed in the browser region." **Judson** discloses "linking the chat client to the browser so that the chat client controls the content displayed in the browser region" ("the first hypertext document . . . link that initiates downloading of the second hypertext document . . ."--column 8, line 45). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson "linking the chat client to the browser so that the chat client controls the content displayed in the browser region" ("the first hypertext document . . . link that initiates downloading of the second hypertext document . . ."--column 8, line 45) with the teachings of Volano above, because using the steps of "linking the chat client to the browser so that the chat client controls the content displayed in the browser region" would have given those skilled in the art the tools to link chat data controls to the client. This gives users at the client the benefit of using browser functions when operating in the chat mode.

with respect to dependent claim 15, **Volano** discloses "linking the chat client to the browser through an application program interface of the browser" ("administrative features include modification of all user-interface text . . ."--page 1 of 2).

With respect to dependent claim 16, **Volano** discloses "in response to the chat content received by the computer, invoking the chat client through the application

program interface, so that the chat content is displayed in the chat region" ("VolanoChat

supports banner advertisements in its chat rooms . . ."--page 1 of 2).

With respect to dependent claim 17, **Volano** discloses "so that the chat content is

displayed in the chat region, the chat content being of a particular MIME type" ("the first

Java based chat solution . . . complete administrative control . . ."--page 1)

With respect to dependent claim 18, **Volano** does not disclose "so that the chat

content is displayed in the chat region, the chat client including a file having a particular

extension." **Judson** discloses "so that the chat content is displayed in the chat region,

the chat client including a file having a particular extension" ("supports files in the form

of documents and pages . . . protocol that provides user access to files . . ."--column 3,

line 53). It would have been obvious at the time of the invention for one of ordinary skill

in the art to have combined the teachings of Judson "so that the chat content is

displayed in the chat region, the chat client including a file having a particular extension"

("supports files in the form of documents and pages . . . protocol that provides user

access to files . . ."--column 3, line 53) with the teachings of Volano above, because

using the steps of "so that the chat content is displayed in the chat region, the chat

client including a file having a particular extension" would have given those skilled in the

art the tools to recognize and display data according the extension without opening the

entire file.

With respect to dependent claim 19, **Volano** discloses "linking the chat client to

the browser through the application program interface, the application program interface

being implemented as a plug-in architecture" ("chat technologies, such as browser plug-

ins . . ."--page 1 of 2).

With respect to dependent claim 20, **Volano** discloses "an ActiveX architecture"

("Volcano server runs on any platform that supports Java, including Microsoft . . ."--page

1 of 2).

With respect to dependent claim 21, **Volano** discloses "displaying the chat

content in the chat region" ("Java based chat solution to offer in-room advertising . . ."--

page 1 of 2).

With respect to dependent claim 22, **Volano** discloses "displaying the browser

content in the browser region" ("Browser plug-ins, Internet Relay chat . . ."--page 1 of 2).

With respect to dependent claim 23 and 66-68, **Volano** does not disclose "the

browser content including a markup language document." **Judson** discloses "the

browser content including a markup language document" ("HTML tag is a "comment," . .

. by the browser . . . HTML elements . . ."--column 5, line 6). It would have been

obvious at the time of the invention for one of ordinary skill to have combined the

teachings of Judson "the browser content including a markup language document"

("HTML tag is a "comment," . . . by the browser . . . HTML elements . . ."--column 5, line

6) with the teachings of Volano above, because using the step of "the browser content

including a markup language document" would have given those skilled in the art the

tools to view markup language via a browser. This gives users the ability to view

interactions with information on the Internet.

With respect to claim 24, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 3 and is similarly rejected.

With respect to dependent claim 25, **Volano** does not disclose "establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region." **Judson** discloses "establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region" (the browser may be suitably programmed to queue the mini web page . . ."--column 6, line 42). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson "establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region" (the browser may be suitably programmed to queue the mini web page . . ."--column 6, line 42) with the teachings of Volano above, because using the steps of "establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region" would have given those skilled in the art the ability to send and retrieve chat functions from embedded web pages and browsers. This allows users to communicate faster in chat rooms and the like.

With respect to claims 26 and 27, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 3 and are similarly rejected.

With respect to independent claim 28 and dependent claims 29-47, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 10 and dependent claims 11-27. In independent claim 28 and

dependent claims 29-47, Applicant claims a system which contains means corresponding to the steps of the method of independent claim 10 and dependent claims 11-27.

With respect to independent claim 48 and dependent claims 49-65, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 10 and dependent claims 11-27. In independent claim 48 and dependent claims 49-65, Applicant claims a computer program product which contains means corresponding to the steps of the method of independent claim 10 and dependent claims 11-27.

As per claims 69-70, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10 and 28, above and are similarly rejected.

As per claims 71-83, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10-27 and are similarly rejected.

Response to Arguments

4.   Applicant's arguments filed 6/06/03 have been fully considered but they are not

persuasive.

--As per applicant's arguments regarding "Anupam does not state or suggest that

the text-chat communications are synchronized with the web browsing . . .", examiner

maintains that Aupam's "text-chatting" element clearly teaches a synchronized/"dynamic

linking" way of chat exchanging data in a HTML browser environment.

--As per applicant arguments regarding "Anupam simply discloses that the

collaborators are presented with an ability to establish chatting connections . . . does not

teach or suggest that the chatting sessions are synchronized withy the browser action . .

.", examiner maintains that Anupam's collaborators ability to establish chat connections,

is illustrative of the synchronization of a chat session via a browser as indicated in

applicant's claim language. Further, both applicant's and Anupam teachings result in a

text-chat connections (exchanging text data) in a networking environment (HTML, which

requires the use of a browser for communication purposes).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Alford W. Kindred whose telephone number is 703-305-

3802. The examiner can normally be reached on Mon-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim Vu can be reached on 703-305-4393. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

Alford W. Kindred
Patent Examiner
Tech Ctr. 2100
January 19, 2004